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**This Opinion is Not
Citable as Precedent
of the TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

National Registry of Environmental Professionals
v.
American Indoor Air Quality Council

Opposition No. 91153881
to application Serial No. 76292119
filed on July 30, 2001

Thomas E. Smith of Barnes & Thornburg for National Registry
of Environmental Professionals

Robert Kamman, Esq. for American Indoor Air Quality Council

Before Simms, Hohein and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

American Indoor Air Quality Council [hereinafter
applicant] has applied to register CERTIFIED INDOOR AIR
QUALITY TECHNICIAN (CIAQT), on the Principal Register, as a
certification mark in International Class B. The mark
"certifies that the person using the mark has successfully
satisfied specific levels of education, experience and
knowledge in the field of indoor air quality," and the
services provided by users of the mark are identified as

"investigation data collection, analysis, recommendations and remediation services provided by technicians in the field of indoor air quality."

The application was filed based on a claim of use of the mark in commerce, but was later amended to change the basis to intent to use the mark in commerce. The application includes a disclaimer of exclusive rights in CERTIFIED INDOOR AIR QUALITY TECHNICIAN.

National Registry of Environmental Professionals [hereinafter opposer] has opposed registration of the mark by applicant, asserting alternative claims under Sections 2(d) and 2(e)(1) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1052(e)(1). Opposer does not refer to these sections of the statute, but it is clear from the notice of opposition that it has asserted a claim that it is a prior user of a similar mark and that there is a likelihood of confusion (the Section 2(d) claim) and, in the alternative, has asserted that coupling of the "parenthetical initial letters CIAQT" with the disclaimed and descriptive words CERTIFIED INDOOR AIR QUALITY TECHNICIAN does "not avoid the descriptive character of the mark as a whole" (the Section 2(e)(1) claim).

Applicant, in its answer, has clearly denied the allegations relating to the existence of a likelihood of confusion. In fact, in addressing paragraphs 9 and 10 of

the notice of opposition, which set forth opposer's alternative claim of descriptiveness, applicant denies a likelihood of confusion but does not specifically deny that its proposed mark is descriptive. However, we do not view applicant as having conceded the claim of descriptiveness, insofar as it has included the statement that "Applicant denies all other allegations in Opposer's Notice, not already specifically denied herein."

Apart from the pleadings and the involved application, the record consists of the transcript of testimony of opposer's executive director, the 18 exhibits introduced by opposer during that testimony, and the one exhibit introduced by applicant during that testimony. Also technically a part of the record is a testimony deposition taken by applicant, however, as discussed below, it has not been submitted for our consideration.

According to opposer's brief -- the only brief that was filed -- both opposer and applicant took testimony, specifically, one deposition each. Applicant, however, did not file the transcript of the testimony of the one witness it deposed.¹ Thus, the only indication we have of the

¹ The Board contacted applicant's counsel regarding the transcript, who stated that he had thought opposer's counsel would have filed it but who nonetheless indicated that he would forward a copy by fax. None has been received. Therefore, while the deposition is part of the record in this case, we have not been able to review the testimony.

content of the testimony of applicant's witness comes from the references thereto in opposer's brief. (Again, applicant did not file a brief.)

Trademark Rule 2.123(h), 37 C.F.R. § 2.123(h), provides that a transcript of any testimony deposition taken during a Board proceeding must be filed with the Board. When the party that has taken a deposition does not file it, the adverse party may file a copy with the Board, but opposer did not offer its copy for our review. As applicant has not filed the transcript of the testimony of its witness, and in accordance with our discretion under Rule 2.123(h), we shall not further hear or consider anything from applicant in regard to its testimony deposition. We therefore accept as accurate the characterization of the testimony by opposer, and the excerpts quoted by opposer in its brief.²

Opposer's Section 2(d) claim is based on its asserted ownership of a common law certification mark. The testimony and exhibits of opposer's executive director, Richard Young, are sufficient to establish that opposer used the term CERTIFIED INDOOR AIR QUALITY MANAGER (CIAQM) long before applicant filed its involved application to register

² While we do not have the transcript of the testimony of applicant's witness, we do have the only exhibit introduced by that testimony, for according to opposer, the only exhibit introduced during applicant's testimony was the same as the single exhibit applicant introduced during the taking of testimony from opposer's witness.

CERTIFIED INDOOR AIR QUALITY TECHNICIAN (CIAQT) as a certification mark. The record also shows that opposer has used the complete term and the component parts, i.e., the words CERTIFIED INDOOR AIR QUALITY MANAGER and the initialism CIAQM, in connection with its administration of an examination for certifying those who have taken and passed its exam, and who have submitted other documentary materials regarding their qualifications, as meeting opposer's standards for certification, specifically, that such individuals possess a "basic degree of knowledge pertinent to the coordination and management of ventilation, toxicology, molds, chemistry and environmental health of indoor environmental programs and projects." Young test. dep., exh. 1. Given the similarities of the two asserted marks, and the similarities of the certification services performed by opposer and which applicant proposes to offer, we have no doubt there would be a likelihood of confusion among consumers, if we were to find that the respective terms employed by the parties were marks. Opposer's Section 2(d) claim fails, however, because it has not proven that the term it employs is a distinctive mark.

As the asserted owner of a common law certification mark, it is part of opposer's burden as plaintiff to prove the distinctiveness of its mark. See, e.g., Institut National Des Appellations v. Brown-Forman Corp., 47 USPQ2d

1875 (TTAB 1998) (opposers asserted and proved ownership of unregistered certification mark COGNAC). See also, Otto Roth & Company, Inc. v. Universal Foods Corporation, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981) (in an opposition or cancellation proceeding, the plaintiff relying on an unregistered term to argue likelihood of confusion under §2(d) must prove distinctiveness, either by inherent distinctiveness or acquired distinctiveness through secondary meaning.)

In this respect, opposer's testimony and exhibits clearly are insufficient. Certain exhibits establish that INDOOR AIR QUALITY and IAQ are used not only by opposer but also by others, including the United States Environmental Protection Agency (EPA). Opposer's exhibit 19, for example, is an EPA document calling for managers of federal facilities to appoint an Indoor Air Quality (IAQ) Manager. Also, on cross-examination, opposer's witness testified that its own exhibit 15 describes "how to become a Certified Indoor Air Quality Manager and it lists information about how to do that. ... it says choose your certification provider and it lists WSO, the World Safety Organization, National Registry of Environmental Professionals [opposer] and [the] Environmental Education Foundation." Young test., pp. 47-48. Thus, not only do others use the term "Indoor Air Quality (IAQ) Manager" but there are also others certifying

such individuals. Finally, we note that Mr. Young, on cross-examination, could only testify that opposer first certified an Indoor Air Quality Manager in 1996, but could not testify, even when asked for approximate figures, as to the number of individuals certified that year or in any subsequent year. Young, pp. 60-61.

While opposer has failed to prove its Section 2(d) claim, it has carried its burden of proof on its Section 2(e)(1) claim. The same evidence that effectively establishes that opposer's asserted mark lacks distinctiveness serves to prove that applicant's proposed mark CERTIFIED INDOOR AIR QUALITY TECHNICIAN (CIAQT) would not be viewed as a mark but as a descriptive term.

As noted earlier, applicant has disclaimed the entire mark, but for the parenthetical initialism.³ Opposer's evidence is sufficient to establish that opposer and others in the field routinely utilize initialisms, often in conjunction with the words that the initials represent. Similarly, the specimen of use submitted by applicant with its application shows adjacent listings of "Certified Indoor Air Quality Professional," "Certified Indoor Air Quality

³ Applicant's witness admitted that applicant has no exclusive rights in "indoor air quality" or "IAQ" and that "technician" is descriptive if not generic. Opp. brief, p. 9, characterizing testimony of applicant's witness. Further, we agree with opposer that "certified" is a generic term when used as a word in a certification mark.

Technician," and dates for "CIAQP/T study/review course w/exam." Thus, the record is clear that individuals seeking certification in Indoor Air Quality (IAQ) would routinely associate the descriptive terms for various types of certifications with the initials for the words comprising those terms. Moreover, as applicant seeks to register the composite of the words coupled with their initials, it would be obvious to any individual seeking to become a "Certified Indoor Air Quality Technician" that CIAQT is the initialism for that term and would not be perceived as any more distinctive than the disclaimed words. See Southwire Co. v. Kaiser Aluminum & Chemical Corp., 196 USPQ 566, 574 (TTAB 1977) ("Under these conditions and circumstances, the climate in the electrical industry is such that the members thereof are likely to and do, in fact, equate 'ALR' with 'aluminum revised' and with wire produced to be used with 'CO/ALR' connecting devices; and applicant, itself as exemplified by its exhibits, has willingly or unwittingly served to connect 'ALR' wire with the 'CO/ALR' devices.").

Decision: The opposition is sustained insofar as it asserts a claim of descriptiveness under Section 2(e)(1) of the Trademark Act, and registration to applicant is refused, but the opposition is dismissed insofar as it asserts a claim under Section 2(d) of the Trademark Act.